REMARKS

At the time of the Office Action dated March 21, 2007, claims 1-5, 7, 9-13, 15, 17-21, and 23 were pending and rejected in this application. Independent claims 1, 9, and 17 have been amended to clarify that the text is in a field of the control and the text is inputted into the field, and independent claims 7, 15, and 23 have been amended to clarify that the text is in a field of the control and the text is outputted from the field. Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-5, 7, 9-13, 17-21, AND 23 ARE OBJECTED TO

On pages 2 and 3 of the Office Action, the Examiner objected to the claims. Specifically, the Examiner asserted:

> "wherein said text is an input field" is not enabled, nor described anywhere in the disclosure in a way that enables an artisan to make or use this limitation. In claims 7, 15, and 23, "wherein said text is an output field" is not enabled, nor described anywhere in the disclosure in a way that enables an artisan to make or use this limitation. For purposes of expediting prosecution, the Examiner has interpreted the text to be located in an input field. Appropriate correction is required.

Applicant notes that independent claims 1, 9, and 17 have been amended to clarify that the text is in a field of the control and the text is inputted into the field, and independent claims 7, 15, and 23 have been amended to clarify that the text is in a field of the control and the text is outputted from the field. Support for these clarifying limitations are found throughout the originally filed specification. For example, reference is made to lines 5 of page 3, which states that "the text may be found in an input field, and output field." In lines 8-9 on page 6, it is written that a typical form includes various controls that includes entry filed and output text fields. Thus, Applicant respectfully submits that the above-identified language is enabled by the specification.

CLAIMS 1-5, 7, 9-13, 17-21, AND 23 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 3 and 4 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-5, 7, 9-13, 17-21, and 23, is directed to non-statutory subject matter. This rejection is respectfully traversed.

At the outset, Applicant notes that the Examiner is obligated to reject each claim on all valid grounds available[1]. However, in the **SIX** Office Actions proceeding the present Office Action, the Examiner has failed to rejection the claims under 35 U.S.C. § 101. In this regard, Applicant questions why the Examiner has waited until the seventh Office Action to present this rejection. Furthermore, Applicant strongly requests that if the Examiner is to maintain this rejection, the Examiner is to fully and completely explain and place on the record the reasons (i) why the Examiner believed the claims were directed to statutory subject matter prior to the present Office Action and (ii) why the Examiner's positioned has changed in the present Office Action.

Notwithstanding the Examiner's improper failure to previously raise this rejection, Applicant notes that despite the extreme shortness of the Examiner's analysis, the Examiner has committed several error in rejecting the claims. For ease of reference, the entirety of the Examiner's rejection under 35 U.S.C. § 101 is reproduced below:

> Claims 1-5,7,9-13, 15, and 17-21, and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. More specifically, claim 1 merely recites functional descriptive material, an abstract idea, or computer program per se (see page 53, Interim Guidelines for Examination of Patent Applications, regarding claims 17-21, and 23-computer program product), without any embodiment. The claimed invention falls within one of the statutory classes, i.e. process/apparatus (claims 1-5, 7, 9-13, and 15), however includes a judicial exception, as an abstract idea, wherein the patentable process/apparatus, is in reality seeking patent protection of the computer program in the abstract as evidenced by claim 17. The

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[1] See M.P.E.P. § 707.07(g).

> Examiner notes the mere manipulation of data, in claim 1, wherein there is no physical transformation and no useful, concrete and tangible result. Therefore the claims are non-statutory.

At the outset, Applicant notes that the Interim Guidelines for Examination of Patent Applications is outdated. In this regard, the Examiner is referred to Revision 5 of the 8th Edition of the M.P.E.P., which was issued in August 2006. Specifically, the Examiner is referred to sections 2106 and 2106.01.

Regarding the Examiner's assertion the claimed invention "includes a judicial exception, as an abstract idea, wherein the patentable process/apparatus, is in reality seeking patent protection of the computer program in the abstract as evidenced by claim 17," the Examiner is specifically directed to M.P.E.P. § 2106.01, which states:

> When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claims 17-21 and 23 each recite a "computer program product recorded on computer readable medium." Since a computer readable medium is an article of manufacture, claims 17-21 and 23 are directed to statutory subject matter.

As described in M.P.E.P. § 2106.01(IV)(C)(3), the concept of "preemption" occurs when a judicial exception (i.e., abstract idea, law of nature, or natural phenomenon) is recited as part of statutory subject matter (e.g., a process or a device such as a computer). As described in M.P.E.P. § 2106.01(IV)(D):

> If the record as a whole suggests that it is more likely than not that the claimed invention would be considered a practical application of an abstract idea, natural phenomenon, or law of nature, then USPTO personnel should not reject the claim.

However, a claim may not cover "every 'substantial practical application' of an abstract idea."

Therefore, in such a situation, in order to reject the claim under 35 U.S.C. § 101, the Examiner is

required to perform the following:

> identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers
> every substantial practical application thereof.

The Examiner, however, has not performed such an analysis.

      With regard to claim 1, the Examiner asserted "the mere manipulation of data, in claim 1,

wherein there is no physical transformation and no useful, concrete and tangible result."

Applicant disagrees with the Examiner's conclusion. Although issued as a patent prior the <u>State</u>

<u>Street Bank</u> decision, reference is made to U.S. Patent No. 5,333,184 (hereinafter the '184

patent). Claim 1 of the '184 patent is reproduced below:

> 1.   A method for use in a telecommunications system in which interexchange
> calls initiated by each subscriber are automatically routed over the facilities of a
> particular one of a plurality of interexchange carriers associated with that
> subscriber, said method comprising the steps of:
>
>   generating a message record for an interexchange call between an
> originating subscriber and a terminating subscriber, and
>
>   including, in said message record, a primary interexchange carrier (PIC)
> indicator having a value which is a function of whether or not the interexchange
> carrier associated with said terminating subscriber is a predetermined one of said
> interexchange carriers.

Upon reviewing this claim, while considering the Examiner's assertion that claim 1 of the present

invention has "no physical transformation and no useful, concrete and tangible result" Applicant

is unclear as to what, in claim 1, of the '184 patent, would meet the Examiner's requirements. No

physical transformation occurs in claim 1 of the '184 patent. Moreover, both claims describe, as

the result, creating a data object (i.e., claim 1 of the present invention recites "encapsulating said steps of initializing and identifying in order to make a reusable data object" and claim 1 of the '184 patent recites "including, in said message record, a primary interexchange carrier (PIC) indicator." Therefore, based upon these similarities, it is apparent that the Examiner would have rejected claim 1 of the '184 patent for the same reasons the Examiner has rejected claim 1 of the present application.

Applicant has referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in <u>AT&T Corp. v. Excel Communications, Inc.</u>[2] The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101." Thus, Applicant submits that the Examiner's rationale for rejecting the claims of the present invention is inconsistent with the decision by the Federal Circuit that the claimed subject matter recited in the '184 patent is directed to statutory subject matter.

Since the Examiner is aware of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, the Examiner is directed to the first page of the Interim Guidelines. In this regard, Applicant notes that the Federal Circuit decision of <u>AT&T Corp.</u> is mentioned side-by-side with the <u>State Street Bank</u> decision. Therefore, it is readily apparent that the Federal Circuit decision of <u>AT&T Corp.</u> is still good law, which <u>must</u> be followed by the Examiner.

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[2] 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

Therefore, for the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 1-5, 7, 9-13, 17-21, and 23 under 35 U.S.C. § 101 is not viable and, hence, Applicant solicits withdrawal thereof.

CLAIMS 1-5, 7, 9-13, 17-21, AND 23 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY HAMANN, U.S. PATENT NO. 6,092,036

On pages 4-6 of the Office Action, the Examiner asserted that Hamann discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.[3] As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[4] This burden has not been met.

At the outset, Applicant notes that the Examiner has completely ignored the claimed limitations regarding the "reusable control." Moreover, the teachings of Hamann are unrelated to a reusable control. Instead, Hamann is directed to a system and method for translating text in a computer program. Moreover, as clarified by the present amendments to the claims, the text to be translated in a field of the control and the text is either inputted into the field or outputted from the field. Thus, the translation occurs to text that is found in a field of a control. This type

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[3] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).
[4] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.

of translation is fundamentally different from the type of translation performed by Hamann, which is directed to translation of the software itself.

Applicant also notes the Examiner's assertion that "his embedded translator includes encapsulation of the initializing and identifying steps." Applicant respectfully disagrees. The translator 48 of Hamann does not perform the initializing of the parameters. As described in column 4, lines 33-44:

> The application program(s) 24 preferably includes a translator 48, such as a translation algorithm embedded within each application program 24, for obtaining the translation data 34 from the translation master table 30 and the target language text items 44 from the appropriate application text translation table 40. The translator 48 causes the application program 24 to use the target language application text items 44 in the target language indicated by the translation configuration settings 22, as the application program 24 creates or constructs objects, such as windows 50, menus 52, buttons 54 and other objects having associated text, to form a graphical user interface (GUI).

As described therein, the parameters for the target language is found in the configuration settings 22. Moreover, as described in column 3, lines 57-59:

> A translation configuration selector 20 which is part of a system configuration tool, allows a user to select or set one or more translation configuration settings 22, such as a locality setting that identifies the desired target language.

The system configuration selector 20 (see Fig. 2) is completely separated from the translator. Thus, the step of initializing is <u>not</u> encapsulated within the translator program 48, as asserted by the Examiner.

The above argued differences between the claimed invention and the teachings of Hamann undermine the factual determination that Haynes identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicant, therefore, respectfully submits that the imposed rejection of claims 1-5, 7, 9-13, 17-21, and 23 under 35 U.S.C. § 102 for anticipation based upon Haynes is not factually viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

> When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 18, 2007

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